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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,362	01/05/2004	Radhakrishnan Janardanan Nair	AA611	2195
27752 7590 10/03/2008 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
			EXAMINER CHAPMAN, GINGER T	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 10/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/751,362

**Applicant(s)**

NAIR ET AL.

**Examiner**

Ginger T. Chapman

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 22-24 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/29/2008; 09/16/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2008 has been entered.

***Status of the claims***

2. Claims 30-32 are added, claims 10 and 12-21 are previously cancelled; claims 1-9, 11 and 22-32 are pending in the application, claims 25-29 are withdrawn from consideration as being drawn to a nonelected invention.

***Allowable Subject Matter***

3. The indicated allowability of claim 24 is withdrawn in view of the newly discovered reference to Yeo (US 5,503,076). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-9, 11, 22-24 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al (US 6,558,499) in view of Yeo (US 5,503,076).

7. With respect to claims 1 and 30, Pargass et al disclose an absorbent product (10) comprising a package and at least n absorbent articles contained in the package, wherein n is greater than 10 (column 5, lines 3-5), each of the absorbent articles having a body contacting surface (14) and a garment contacting surface (22) opposing the body contacting surface, each of the absorbent articles comprising: a component material (26) (c. 7, l. 54; fig. 3; c. 8, l. 27) disposed between the body contacting surface (14) and a garment contacting surface (22), the component material (26) having a printed graphic (21, 21') printed directly on the garment contacting surface comprising the outer layer of the backsheet (figs. 1 and 2); wherein the printed graphic (21, 21') of each of the n absorbent articles is different from the graphic of each of the remaining absorbent articles (c. 15, ll. 44-52 and c. 15, ll. 60 to c. 16, ll. 1-2) and all of the printed graphics (21, 21') of the n absorbent articles have a predetermined association (c. 10, ll. 17-21; see also c. 6, ll. 59; c. 7, ll. 12-15; c. 10, ll. 36-37). See also c. 2, ll. 9-13, disclosing that printed graphics having a predetermined association are known in the diaper art.

8. Pargass discloses the claimed invention except for the backsheet of each of the articles comprises a microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film. As best depicted in Figures 2 and 3, Yeo teaches a diaper (c. 7, ll. 54-55) having a backsheet 10 comprising a microporous film 14 (c. 5, l. 51) with graphics printed directly on the film (c. 8, ll. 44-48) and the backsheet 10 further comprises a nonwoven material 12 joined with the film and the graphic is visible through the nonwoven (c. 4, ll. 22-24). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the backsheet of Pargass as taught by Yeo since Yeo states, at c. 8, ll. 45-47 and at c. 4, ll. 26-27, that the advantage of forming the article with this design is that the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.
9. With respect to claims 2 and 31, Pargass et al disclose the predetermined association includes a predetermined order (c. 10, ll. 17-21; see also c. 10, ll. 36-37; c. 7, ll. 12-15; c. 6, l. 59, and the n absorbent articles are stacked in the package in accordance with the predetermined order (c. 15, l. 60-67 to c. 16, ll. 1-2).
10. With respect to claims 3 and 5-9, these claims recite the content of the printed matter comprising the graphics, and the predetermined order or randomness of the graphics chosen for the articles. A patentable distinction does not exist between the prior art diapers and the instant claimed diapers because any difference is nonfunctional printed matter and nonfunctional printed

matter does not lend additional patentable weight. The prior art contains all the structure defined in the instant claims.

11. The critical question is whether there is any new and unobvious functional relationship between the printed graphics and the substrate, as per MPEP § 2112.01, III. Here, the answer is no, because both the instant and the prior art graphics are printed on microporous film with nonwoven material comprising the outer cover of the article and the printed graphic is visible through the nonwoven. Outer covers are known in the art to comprise laminates of films and nonwovens in multiple layers, and therefore the claimed graphics do not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*. Therefore the rejection stands as stated.

**III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER  
DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE  
IDENTICAL PRIOR ART PRODUCT**

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, \*\*>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). MPEP § 2112.01, III.

12. It is well known in the packaging art to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or ornamental graphics to induce consumer interest in the article. If articles were patented based on differences in graphics, multiple patents could issue indefinitely for the same article.

13. With respect to claim 4, Pargass et al disclose the predetermined order is an order of usage instruction (c. 6, l. 59; see also c. 6, ll. 55-58).

14. With respect to claim 11, Pargass et al disclose n is selected from 11 to 120 (c. 5, ll. 4-5)

15. With respect to claims 22 and 32, Pargass discloses the claimed invention except for inkjet printed graphics. Yeo teaches inkjet graphics (c. 9, ll. 7-9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Pargass by inkjet printing as taught by Yeo since Yeo states, at c. 8, ll. 66-67 and c. 9, ll. 5-10, that the advantage of using inkjet printing is that the process can handle multi-color printing with no fouling of equipment.

16. With respect to claims 23 and 24, Pargass discloses the claimed invention except for the sheet of material extending from the first to second waist region is microporous film and the graphic is printed directly on the garment facing surface of the film as recited in claim 23, and a nonwoven material joined with the garment facing surface of the film and the printed graphic is visible through the material. As best depicted in Figures 2 and 3, Yeo teaches microporous film 14 and the graphics (fig. 3) printed directly thereon, a nonwoven material 12 joined thereto and

the graphic is visible through the material 12 (c. 4, ll. 20-30). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the article of Pargass as taught by Yeo since Yeo states, at c. 4, ll. 21-30, that the advantage of forming the article with this design is that it provides colorful graphics which are visually appealing; the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass in view of Yeo and further in view of Stavrulov (WO 00/13632).

18. With respect to claim 4, Pargass in combination with Yeo discloses the claimed invention except for the order of graphics are stories, activities, educational, instructions, sales promotions. Pargass discloses, at c. 6, ll. 55-59, that the orders include, *inter alia*, an order of usage instructions, a sequential indication means and combinations thereof, but does not expressly disclose an order illustrating story, an order for daily activity, an order for educational training, an order illustrating child care tips, and an order of sales promotion. Stavrulov, at page 3, lines 15-22 expresses the desire and clear motivation to increase the attractiveness of diapers with graphics in the form of texts and pictures of educational, entertaining, instructive or other nature attractive to a consumer thereby increasing consumer demand for the product. Stavrulov teaches diapers in packages having printed graphics in predetermined associations including, *inter alia*, an order illustrating story, (p. 7, l. 24) an order for daily activity (p. 7, l. 20-23), an order for educational training (p. 7, l. 18), a sequential indication means (p. 7, ll. 19-21), an order of usage



instruction (p. 1, l. 20-21), an order illustrating child care tips (p. 7, l. 21), and an order of sales promotion (p. 12, l. 2).

19. Further, Stavrulov teaches the images do not repeat (p. 8, ll. 9-22). Stavrulov teaches the benefit of each of the printed graphics being different from each other graphic in the package of diapers is that the consumer receives the maximum educational, entertaining and instructional information with each purchase (p. 8, ll. 23-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the variety of graphics having predetermined orders as taught by Stavrulov in the predetermined order of graphics printed on the component material of the diapers of Pargass et al since Stavrulov states at page 11, lines 11-16 that such graphics attract consumer attention and stimulate the purchase of the product by the consumer.

20. Additionally, it is well known to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or to ornamental graphics to induce consumer interest in the article. If articles were patented based on differences in graphics, multiple patents could issue indefinitely for the same article.

#### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1-9, 11, 22-24 and 30-32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
23. Reed et al (WO 99/60973) and (WO 99/32164): teaches graphics printed on backsheets of diapers wherein the backsheets comprise microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.
24. Schleinz et al (US 5,458,590) teaches graphics printed on backsheets of diapers wherein the backsheets comprise microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.
25. Yeo (US 5,695,855) teaches inkjet printing of graphics on film and nonwoven substrates for diaper backsheets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/  
Examiner, Art Unit 3761  
9/30/08

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